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A-8

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/330,134 06/11/99 BETHUNE

A 103602

EXAMINER

IM52/1102

OLIFF & BERRIDGE PLC
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CALCAGNIT

ART UNIT

PAPER NUMBER

12

1762
DATE MAILED:

11/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | |
|------------------------------|----------------------------------|------------------|
| Office Action Summary | Application N . | Applicant(s) |
| | 09/330,134 | BETHUNE, ALAIN |
| | Examiner Jennifer A. Calcagni | Art Unit 1762 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 21 September 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-18 and 30-44 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 44 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-18 and 30-42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>10_11</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the subject matter of all groups is sufficiently related that a thorough search for the subject matter of the elected group would encompass a search for the subject matter of the remaining groups, and that therefore the search and examination of the entire application could be made without serious burden. In addition, Applicant argues that the method cannot be performed with a different apparatus and that the product cannot be made by a materially different process. This is not found persuasive because, as stated in paragraph 3 of paper number 7, the apparatus can be used for applying adhesive or applying water in a clean process. In addition, the apparatus does not require that a hollow article be coated, and the apparatus could therefore be used for coating a planar substrate.

It is well settled that the intended use of a claimed apparatus is not germane to the issue of the patentability of the claimed structure. If the prior art structure is capable of performing the claimed use, then it meets the claim. *In re Casey*, 152 USPQ 235, 238 (CCPA 1967); *In re Otto*, 136 USPQ 459 (CCPA 1963). Furthermore, as stated in paragraph 2 of paper number 5, the inventions are distinct if it can be shown that either: (1) the process can be practiced by another or materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. It remains Examiner's position, as discussed in detail above, that the apparatus has acquired a separate status in the art, and restriction for examination purposes is therefore proper.

In addition, as stated in paragraph 3 of paper number 7, the product can be made by a materially different process/apparatus, such as spray coating, or the product may be hand-painted. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See M.P.E.P. 2113. Furthermore, as stated above, the apparatus is not limited to coating hollow articles and can be used to make a semiconductor wafer or compact disc that is coated with a photoresist, instead of the painted hollow article claimed by Applicant.

While Examiner acknowledges that a complete search for applicant’s method may include a search of the classes and subclasses containing the apparatus and the product, the issues that may arise in determining the patentability of applicant’s method may be very different from the issues that arise in determining the patentability of the apparatus and product.

The requirement is still deemed proper and is therefore made FINAL.

2. Newly submitted claims 43 and 44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: these claims are apparatus claims and would therefore be subject to restriction for the reasons discussed above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 43 and 44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Response to Arguments

3. Applicant's arguments filed on September 21, 2001 have been fully considered but they are not persuasive.

Applicant argues that Clark pours the coating into a hollow article rather than depositing the coating at the center area of the hollow article as claimed by Applicant. Applicant argues that the pouring is not equivalent to placing a coating in the center area spaced from the side wall because the effects of pouring the coating material in to the hollow article results in both the center area and the side wall being deposited with the coating material.

While Examiner acknowledges that the effects of pouring may result in coating material being deposited in both the center area and on the side wall, it is Examiner's position that Applicant's claims are not limited to depositing to depositing the coating materially solely in the center area of the bottom.

It is Examiner's position that the pouring disclosed by Clark would meet the element of Applicant's claim for depositing a predetermined quantity of coating in the fluid state on a center area of the bottom, even though the pouring may also deposit coating material on other parts of the substrate as well. The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); *In re Baxter*, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

Applicant argues that Iwasaki fails to apply a coating that is deposited in a fluid state because the coating used by Iwasaki is dispersed into fine droplets as it is sprayed onto the substrate.

It is Examiner's position that the Iwasaki is spraying liquid droplets onto a substrate, which would inherently mean that the coating is applied in a fluid state. Each individual droplet is inherently in a fluid state, therefore the coating itself would also be deposited in a fluid state. It is Examiner's position that the term "depositing" would include spraying as one means of depositing the coating on the substrate.

Claim Rejections - 35 USC § 112

4. The rejection of claims 1-18 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. The rejection of claims 1-3 and 6 under 35 U.S.C. 102(b) as being anticipated by Hammen (5,763,004) has been withdrawn.

7. Claims 1-2 and 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark (3,804,663).

Examiner maintains the rejection set forth in paragraph 8 of the previous office action mailed May 21, 2001 and as further discussed above in paragraph 3.

8. Claims 1, 10, 15, 34-36, 38-39, and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Iwasaki (5,002,799).

Examiner maintains the rejection set forth in paragraph 9 of the previous office action mailed May 21, 2001 and as further discussed above in paragraph 3.

As to claim 30, it is Examiner's position that the coating material disclosed by Iwasaki would inherently be a paint for the cathode ray tubes.

Claims 34-36, 38-39, and 42 are rejected for the same reasons that claims 1, 10, and 15 were rejected above and in the previous office action.

Claim Rejections - 35 USC § 103

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. The rejection of claim 4 under 35 U.S.C. 103(a) as being unpatentable over Hammen (5,763,004) has been withdrawn.

11. Claims 3-4, 9, 11, and 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark (3,804,663).

As to claims 9 and 11, Examiner maintains the rejection set forth in paragraph 13 of the previous office action mailed May 21, 2001.

As to claims 3-4 and 31, Clark discloses all of the elements claimed by Applicant except that the coating is heated by being raised to a temperature higher than ambient temperature. It is

Examiner's position that the whether the coating material is heated and the temperature to which the coating material is heated will depend on the particular coating material, the viscosity and other attributes of the coating material, and the method of application of the coating material. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the optimum temperature at which to apply the coating material through routine experimentation in the absence of a showing of criticality, including a temperature within the range claimed by Applicant.

As to claim 32, as discussed above and in the previous office action, Clark discloses all of the elements claimed by Applicant except that the rotation of the article is stopped suddenly after the coating has been spread by the desired amount. However, it is Examiner's position that rotation of the article would inherently have to occur once the coating has been applied to the substrate and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the optimum means of stopping rotating of the substrate, including suddenly stopping the rotation, in order to obtain the desired finish quality of the coating.

As to claim 33, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the optimum time at which to stop rotation of the substrate, including before the coating runs down an outside surface of the side wall, in order to avoid unnecessary cleanup steps and to avoid using more of the coating material than is needed.

12. Claims 12-14, 37, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki (5,002,799).

As to claims 12-14, Examiner maintains the rejection set forth in paragraph 14 of the previous office action mailed May 21, 2001.

Claim 37 is rejected for the same reason that claim 14 was rejected above and in the previous office action.

As to claim 40, Iwasaki discloses all of the elements claimed by Applicant except that the rotation of the article is stopped suddenly after the coating has been spread by the desired amount. However, it is Examiner's position that rotation of the article would inherently have to occur once the coating has been applied to the substrate and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined the optimum means of stopping rotating of the substrate, including suddenly stopping the rotation, in order to obtain the desired finish quality of the coating.

Claim 41 is rejected for the same reason that claim 12 was rejected above and in the previous office action.

13. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iwasaki (5,002,799) (hereinafter '799) in view of Iwasaki (5,599,579) (hereinafter '579).

Examiner maintains the rejection set forth in paragraph 15 of the previous office action mailed May 21, 2001.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer A. Calcagni whose telephone number is (703) 305-0595. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00 and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3599 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

JAC Calcagni
jac
November 1, 2001

SPB
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